

Attorney Docket No. 03496/LH

**IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE**



1FW

Applicant(s): H. KOYOMA et al

Serial No. : 10/652,924

Filed : August 28, 2003

For : PRINTER UNIT

Art Unit : 3724

Customer No.: 01933

RESPONSE TO NOTICE OF INCOMPLETE REPLY

Commissioner for Patents
Alexandria, VA 22313-1450

Att: MS MISSING PARTS

S I R :

This is responsive to the NOTICE OF INCOMPLETE REPLY (copy attached) mailed December 10, 2004. Also attached is a copy of a paper dated December 10, 2004 entitled WITHDRAWAL OF PREVIOUSLY SENT NOTICE.

Submitted herewith are the following:

1. Substitute Specification (see Preliminary Amendment filed herewith) which is identical to the original specification, except that the complete ABSTRACT OF THE DISCLOSURE appears on a separate page (previously, the heading ABSTRACT OF THE DISCLOSURE appeared at the bottom of page 29). **No new matter has been added to the Substitute Specification;**
2. Replacement drawing, eight sheets, Figs. 1-7 and 9-11, filed with the original application papers; and
3. Preliminary Amendment adding Fig. 8 to the application.

With respect to the Preliminary Amendment adding Fig. 8 to the application, reference is made to the DECISION ON PETITION mailed December 7, 2004 wherein the Petitions Examiner stated

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313 on the date noted below.

N. Sahadeo
Nalini P. Sahadeo

Dated: December 13, 2004

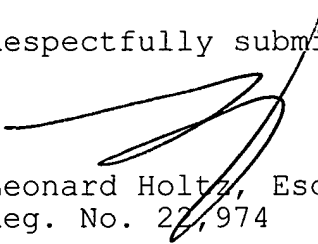
In the event that this Paper is late filed, and the necessary petition for extension of time is not filed concurrently herewith, please consider this as a Petition for the requisite extension of time, and to the extent not tendered by credit card payment, authorization to charge the extension fee, or any other fee required in connection with this Paper to Account No. 06-1378.

that the adding of Fig. 8 to the application by Amendment does not involve new matter since it was part of the original disclosure (due to the incorporation of reference of the priority document). It is respectfully requested that the Preliminary Amendment adding Fig. 8 be approved and entered, and that Fig. 8 be included in the 18-month publication of the present application.

The Preliminary Amendment filed herewith also refers to the Substitute Specification.

It is respectfully submitted that this submission is fully responsive to the outstanding USPTO communication dated December 10, 2004.

Respectfully submitted,



Leonard Holtz, Esq.
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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/652,924	08/28/2003	Hiroyuki Koyama	03496/LH

01933
 FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
 767 THIRD AVENUE
 25TH FLOOR
 NEW YORK, NY 10017-2023



CONFIRMATION NO. 2489

FORMALITIES LETTER



OC000000014728097

Date Mailed: 12/10/2004

NOTICE OF INCOMPLETE REPLY (NONPROVISIONAL)

Filing Date Granted

The U.S. Patent and Trademark Office has received your reply on 09/07/2004 to the Notice to File Missing Parts (Notice) mailed 06/14/2004 and it has been entered into the nonprovisional application. The reply, however, does not include the following items required in the Notice.

The period of reply remains as set forth in the Notice. You may, however, obtain EXTENSIONS OF TIME under the provisions of 37 CFR 1.136 (a) accompanied by the appropriate fee (37 CFR 1.17(a)).

A complete reply must be timely filed to prevent ABANDONMENT of the above-identified application. Replies should be mailed to: Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

The application is informal since it does not comply with the regulations for the reason(s) indicated below.

The required item(s) identified below must be timely submitted to avoid abandonment:

- A substitute specification in compliance with 37 CFR 1.52, 1.121(b)(3), and 1.125, is required. The specification, claims, or abstract page(s) submitted is not acceptable and cannot be scanned or properly stored because:
 - Papers must be legibly written either by a typewriter or mechanical printer in permanent ink or its equivalent in portrait orientation on flexible, strong, smooth, non-shiny, durable, and white paper. Application papers must be presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic reproduction by use of digital imaging and optical character recognition. Pages all are not in compliance with 37 CFR 1.52(a).
- Replacement drawings in compliance with 37 CFR 1.84 and 37 CFR 1.121 are required. The drawings submitted are not acceptable because:
 - The drawings submitted to the Office are not electronically reproducible. Drawing sheets must be submitted on paper, which is flexible, strong, white, smooth, non-shiny,

and durable (see 37 CFR 1.84(e)). See Figure(s) 1-4,6,7,9,10.

Replies should be mailed to: Mail Stop Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

*A copy of this notice **MUST** be returned with the reply.*

HC
Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE



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APPLICATION NUMBER	FILING OR 371(c) DATE	INVENTOR NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/652,924	08/28/2003	Shoyuki Koyama	03496/LH

01933
 FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
 767 THIRD AVENUE
 25TH FLOOR
 NEW YORK, NY 10017-2023

CONFIRMATION NO. 2489

WITHDRAWAL NOTICE

RECEIVED

DEC 13 2004

FRISHAUF, HOLTZ,
GOODMAN & CHICK, P.C.

OC000000014728090

Date Mailed: 12/10/2004

WITHDRAWAL OF PREVIOUSLY SENT NOTICE

The Notice mailed on 07/12/2004 was sent in error and is hereby withdrawn. A corrected Notice is enclosed. The time period for reply runs from the mail date of the corrected Notice. We apologize for any inconvenience this caused.

A copy of this notice MUST be returned with the reply.

Hc
 Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 1 - ATTORNEY/APPLICANT COPY

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DEC 07 2004

OFFICE OF PETITIONS

In re Application of
Koyama, et al.
Application No. 10/652,924
Filed: August 28, 2003
Attorney Docket No. 03496/LH

DECISION ON PETITION

This is a decision on the paper titled "PETITION UNDER 37 CFR 1.182 SUBMITTING OMITTED ITEM AND REQUESTING ORIGINAL FILING DATE", filed September 7, 2004, requesting that the above-identified application be accorded a filing date of August 28, 2003, with Figure 8 of the drawings as part of the original disclosure.

The petition is **DISMISSED**.

The application was filed on August 28, 2003. However, on July 12, 2004, the Office mailed a "Notice of Omitted Item(s) in a Nonprovisional Application", stating that the application had been accorded a filing date of August 28, 2003, and informing applicants that the drawing of Figure 8 described in the specification appeared to have been omitted.

In response, the present petition was filed. Petitioner points out that the application incorporates by reference Japanese application no. JP 2002-251232.

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MPEP § 201.06(c) states that:

. . . an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to **amend** the continuing application to include any subject matter in such prior application(s), **without the need for a petition** (emphasis added).

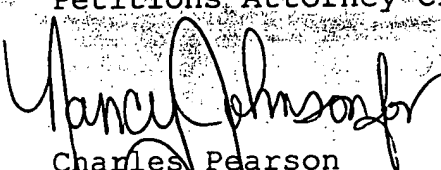
Obviously, in view of the incorporation by reference of the foreign application¹, the drawing of Figure 8 is not new matter if it was a part of the disclosure of that application.

The petition fee of \$130 has been charged to petitioner's deposit account, as authorized.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of August 28, 2003, including an indication in Office records that 8 sheets of drawings were present on filing.

Thereafter the application will be forwarded to Group Art Unit 3724 for consideration by the examiner of the petition filed September 7, 2004, as an amendment requesting entry of Figure 8.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Cliff Congo at 571-272-3207.


Charles Pearson
Director
Office of Petitions

¹ See MPEP 201.13(II)(G).